

REMARKS

In the Office Action mailed December 17, 2004, the Examiner (i) restricted the claims of the application to one of two groups (claims 1-12 or claims 13-14), and (ii) rejected claims 13-14 under 35 U.S.C. § 103(a). After careful review of the cited references, Applicants respectively request reconsideration in view of the following remarks.

I. Election of Group II

As set forth, Applicants affirm the election to prosecute the invention of Group II, claims 13-14, as made by George Lee on 12/09/2004. Applicants have withdrawn claims 1-12, as being drawn to a non-elected invention.

II. Claim Rejections

Claims 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Birch, U.S. Patent No. 5,583,562 in view of Townsend, U.S. Patent Application Publication No. 2003/0009758. In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest all the claim limitations, and there must be some suggestion or motivation to combine or modify the cited references. (MPEP § 2142).

A. The Combination of Birch and Townsend fails to teach or suggest all of the claim limitations

Applicants submit that neither Birch nor Townsend, separately or in combination, teach or suggest (1) “a network operations center creating national programming and multiplexing interactive programming to create a digital interactive streaming media,” or (2) “a set top application system to develop the interactive programming to be displayed to viewers, wherein

the interactive programming is carried by the digital streaming media and enables viewer to select displayed items for purchase,” as in claim 13.

1. A Network Operations Center

Birch teaches a simple transmitter site 100 with a control computer 120, an encoder and multiplexer 130. (Col. 5, lines 8-10). The transmitter site uses conventional multiplexers 418 to implement the frame format of the Birch invention shown in Figures 2A-2C. (Col. 13, line 35-37). Birch, however, does not disclose Appellants’ claimed network operation center for creating a national programming and multiplexing interactive programming. Birch makes no mention of interactive programming. It is not valid for the Examiner to identify the simple transmitter of Birch as a “network operation center” simply to find some correspondence with the limitations of Appellants’ Claim 1. Consequently, Applicants submit that Birch does not teach or suggest “a network operations center creating national programming and multiplexing interactive programming to create a digital interactive streaming media,” as recited in claim 13. Since Birch makes no mention of interactive programming, Birch cannot teach or suggest multiplexing such to create a digital interactive streaming media.

The Office contended that Birch discloses “a network operations center (100) creating national programming and multiplexing interactive programming to create a digital interactive streaming media (Col.5, lines 13-42).” (Office Action, 12.17.04, p. 3). This cited portion does not even mention the type of information created and multiplexed by the claimed network operations center. For example, this cited portion in Birch teaches a transmitter site 100 including audio/video compressors that compress received medium and high data rate data and a control computer 120 that controls a multiplexer 110 to time division multiplex the compressed medium and high data rate streams output from the compressors and the low data rate streams

output from formatters 105(l) to (n) into a serial data stream for output to modulator 130. Modulator 130 then modulates the digital data stream on to a carrier and upconverts the carrier as necessary for transmission via, for example, C, Ku or L band frequencies through a satellite antenna 140. (Col.5, lines 13-42). Thus, this cited portion does not even teach the type of data created or multiplexed by the transmitter. As a result, Applicants submit that Birch does not teach or suggest “creating national programming and multiplexing interactive programming to create a digital interactive streaming media,” as in claim 13.

Similarly, Townsend does not teach the network operations center limitation of claim 13. Townsend teaches a receiver for receiving broadcast digital television signals representing both image data and information data and to display the data derived from the image and information data that represents an interactive image. (section 0012). Applicants submit that Townsend does not even teach a transmitter, or any details as to how the received signal was generated. Naturally, then Townsend does not teach or suggest “a network operations center creating national programming and multiplexing interactive programming to create a digital interactive streaming media,” as in claim 13.

2. A Set Top Application System

With regard to the set top application limitation recited in claim 13, the Office contended that Birch did not disclose a set top application system as recited in claim 13, and also that “Townsend does not mention about it” either. (Office Action, 12.17.04, p. 4). However, the Office asserted that the “set top application system to develop the interactive programming to be displayed to viewers” was inherent within Townsend, because “Townsend received interactive TV signals representing both image data and information data, as described in section 0013 and page 3, section 0050-0053, in which Townsend describes as interactive menu template (see

sections 0050-0052 of page 4; page 5, section. 0064).” (Office Action, 12.17.04, p. 4). The Office further contended that these “interactive menu templates must be generated by some type of application software (set top application system), i.e., authored tool, so that Townsend’s system could perform as disclosed.” (Office Action, 12.17.04, p. 4).

Applicants respectfully traverse. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest all the claim limitations. (MPEP § 2142). Since Townsend does not disclose a set top application system, and since the Examiner asserts the same, Townsend does not teach claim 13 in as much detail as the limitations of the claim require.

Further, Applicants submit that since Townsend does not teach or suggest “a digital interactive streaming media,” as in the network operations center limitation of claim 13, then Townsend cannot teach or suggest “a set top application system to develop the interactive programming to be displayed to viewers, wherein the interactive programming is carried by the digital streaming media,” as in claim 13. (Emphasis added).

Since the proposed combination of Birch and Townsend does not teach or suggest all of the limitations of claim 13, the asserted combination does not obviate claims 13-14.

B. Applicants submit that there is no suggestion within either Birch or Townsend to make the asserted combination

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. (MPEP §2143). Thus, “[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make

the proposed substitution, combination, or other modification.” (MPEP §2143.01). Consequently, to make a successful §103(a) obviousness rejection, the Office must show some objective teaching in the prior art or explain how one of ordinary skill in the art would be motivated to combine the relevant teachings. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Applicants submit that there is no teaching or suggestion within either Birch or Townsend to make the proposed combination. Applicants submit that Birch does not teach or suggest any type of interactive programming or services in connection with its transmitter invention. And Townsend is simply directed toward a receiver for displaying interactive images on a tv, and makes no mention of an interactive information distribution system delivering digital interactive streaming media over a large geographic area. Thus, Birch is directed toward signal transmission, while Townsend is directed toward signal reception. Each reference is concerned with solving a different problem. As a result, there is no suggestion within either Birch or Townsend to combine their teachings to obviate the present claims since the references are directed toward opposite ends of a system.

Applicants contend that combining the teachings of Birch and Townsend to obviate the present claims uses impermissible hindsight because express motivation to combine the references is lacking. A combination of Birch and Townsend to obviate the present claims uses knowledge gleaned from Applicants’ disclosure, and as such, the combination is improper.

The Office contended that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Birch with Townsend so to provide to user a wide range of available interactive services, i.e., online shopping, in which the system could establish a telecommunication link to a remote site for online transfer of data therewith in response to the selection of services (section 0013-0014).” (Office Action, 12.17.04, p. 4-5). However, the

mere fact that references can be combined or modified does not render the resultant combination proper unless the references also suggest the desirability of the combination. (MPEP §2143.01). Birch does not suggest creating national programming and multiplexing interactive programming to create a digital interactive streaming media. Similarly, Townsend does not suggest transmission of such components either since it is directed toward methods to receive and display broadcast information.

Applicants submit that the Office has not shown some objective teaching in the cited references or explained how one of ordinary skill in the art would be motivated to combine the relevant teachings. Since there is no suggestion or motivation to combine Birch and Townsend to render claims 13-14 obvious, the combination is improper for this rejection. Thus, the rejection of claims 13-14 over the combination of Birch and Townsend should be withdrawn.

CONCLUSION

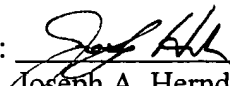
Applicants respectively submit that in view of the remarks above, all of the pending claims are in condition for allowance and such action is respectively requested. The Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.

Respectfully submitted,

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Date: 3/17/05

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